

03-24-00  
Corres. and MailBOX AF Response Under C.F.R. § 1.116  
Expedited Procedure  
Group Art Unit 1634\$ AF  
GP 1631

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dean L. Engelhardt et al.

Serial No. 08/486,066 Group Art Unit: 1631 MAR 3 1 2000  
Filed: June 7, 1995 Examiner: Ardin Marschel, Ph.D. TECH CENTER 1600/2900

Title: A SUGAR MOIETY LABELED NUCLEOTIDE AND COMPOSITION COMPRISING SAME

**FILED BY EXPRESS MAIL**  
**BOX AF**#15  
PLUNKETT  
4/5/00Honorable Commissioner of  
Patents and Trademarks  
Washington, D. C. 20231

Sir:

Transmitted herewith is an Amendment Under 37 C.F.R. § 1.116 in the above-identified patent application.

The fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total	98	Minus	101	= 0	X 18	\$ 0
Indep	3	Minus	3	= 0	X 78	\$ 0
( )	First Presentation of Multiple Dependent Claims			+ 130	\$ 0	
	TOTAL ADDITIONAL FEE					\$ 0

( ) Charge Deposit Account No. 05-1135 in the amount of \$ \_\_\_\_\_.  
  
( ) A check in the amount of \$ \_\_\_\_\_ is attached. The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 05-1135: any filing fees under 37 C.F.R. §1.16 for the presentation of extra claims and any patent application processing fees under 37 C.F.R. §1.17.

Copies are being provided in triplicate.

Also enclosed: Request For An Extension Of Time (Three Months) Under 37 C.F.R. §1.136(a) and Notice Of Appeal To The Board Of Patent Appeals And Interferences

Respectfully submitted,

  
Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicant(s)

March 28, 2000

Date

ENZO DIAGNOSTICS, INC.  
c/o Enzo Biochem, Inc.  
527 Madison Avenue (9th Fl.)  
New York, New York 10022  
Tel. (212) 583-0100  
Attorney's Docket No.: Enz-5(D5)(C2)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No. EL522278608US	
Deposit Date MARCH 28, 2000	
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 110 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231	
Ronald C. Fedus MAR 28 2000	
Reg. No. 32,567 Date	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dean L. Engelhardt et al. )  
Serial No. 08/486,066 ) Group Art Unit: 1631 PLUMKET  
Filed: June 7, 1995 ) Examiner: Ardin Marschel, Ph.D. 4/5/00  
Title: A SUGAR MOIETY LABELED )  
NUCLEOTIDE AND )  
COMPOSITION COMPRISING )  
SAME )



527 Madison Avenue, 9<sup>th</sup> Floor  
New York, New York 10022  
March 28, 2000

**FILED VIA EXPRESS MAIL**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. §§1.56 & 1.97-1.98**

Dear Sirs:

This Supplemental Information Disclosure Statement follows Applicant's September 11, 1995 Information Disclosure Statement Under 37 C.F.R. §§1.56 and 1.97-1.98.

Pursuant to the provisions of 37 C.F.R. §§ 1.97-1.98, and in full compliance with their duty of disclosure under 37 C.F.R. § 1.56, Applicants, through their attorney are bringing the following twenty (20) documents to the further attention of the U.S. Patent and Trademark Office and the Examiner handling their above-identified application:

<b>EXPRESS MAIL CERTIFICATE</b>	
<b>"Express Mail" Label No.:</b>	<b>EL 52227860BJS</b>
<b>Deposit Date:</b>	<b>March 28, 2000</b>
<p>I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.110 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231</p>	
 <span style="float: right;">MAR 28 2000</span>	
<p><b>Ronald C. Fedus</b>  <b>Re: Exhibit 32 567</b></p>	

Enz-5(D5)(C2)

1. Kochetkov, N.K. and Budovskii, E.I., Editors, Organic Chemistry of Nucleic Acids, Part B, Chapter 9, "Reactions of the Carbohydrate Residues of Nucleic Acids," pages 449-476 Plenum Press, London and New York (1972) (Exhibit 1);
2. Armstrong, V.W. and Eckstein, F., "Interaction of Substrate Analogues With Escherichia coli DNA-Dependent RNA Polymerase," Eur. J. Biochem. 70:33-38 (1976) (Exhibit 2);
3. Rozovskaya T.A. et al., "Introduction of a Fluorescent Label at the 3'-OH End of DNA and the 3'-OH End of the Growing RNA Chain," Molekulyarnaya Biologiya 11(3):598-610 (1977) (Exhibit 3);
4. Petrov, A.I. and Sikkorukov B.I., "Spin-labeled polynucleotides," Nucleic Acids Research 8(18):4221-4234 (1980) (Exhibit 4);
5. Petrov, A.I., "Complex formation between spin-labeled polyuridylic acid and pyrimidine nucleosides," Nucleic Acids Research 8(23):5913-5929(1980) (Exhibit 5);
6. Hiratsuka T., and Uchida, K., "Preparation And Properties of 2'(or 3')-O-(2,4,6-Trinitrophenyl) adenosine 5'-Triphosphate, An Analog Of Adenosine Triphosphate," Biochimica et Biophysica Acta 320:635-647 (1973)(Exhibit 6);
7. Kourilsky et al., UK Patent Application No GB 2 019 408A filed April 12, 1979 (Exhibit 7);
8. Bauman, J.G.J. et al., "Cytochemical Hybridization with Fluorochrome-labeled RNA," J. Histochem. Cytochem. 29:227-237 (1981) (Exhibit 8);
9. Broker, T.R. et al., "Electron microscopic visualization of tRNA genes with ferritin-avidin: biotin labels," Nucleic Acid Research 5(2):363-384 (1978) (Exhibit 9);
10. Sodja, A. and Davidson, N., "Gene mapping and gene enrichment by the avidin-biotin interaction: use of cytochrome-c as a polyamine bridge," Nucleic Acid Research 5(2):385-401 (1978) (Exhibit 10);
11. Kourilsky et al., German Patent Application DE 29 15 082A1 filed April 12, 1979 (Exhibit 11);
12. Daniel, F.B. and Beerman, "Osmium (VI) Complexes of the 3',5'-Dinucleoside Monophosphates, ApU and UpA," E.J. Biochemistry 15:565-568 (1976) (Exhibit 12);
13. Eberhard W. et al., "Galactopyranosyl-Beta(1 => 3')- ribonucleosides – structural evidence and synthesis," Nucleic Acids Research Symposium Series Exhibit 9:15-19 (1981) (Exhibit 13);
14. Saffhill, R., and Hall, J.J., "A convenient preparation of isomerically pure nucleoside 5'-monophosphates from unprotected nucleosides," Carbohydrates Nucleosides Nucleotides 8:573-583 (1981) (Exhibit 14);

15. Scherberg N.H., US Patent Exhibit 4,260,737 issued 4/7/81 (Exhibit 15);
16. Kourilsky, German Patent Exhibit DE 2915082 C2 filed April 12, 1979 (Exhibit 16);
17. Erlanger, B.F. et al., "Antibodies specific for ribonucleosides and ribonucleotides and their reaction with DNA," Proc.Natl.Acad.Sci. 52:68-74 (1964) (Exhibit 17);
18. Suzuki S. et al., "The binding sites of nucleosides or nucleotides to diethylenetriaminecobalt (III)," Bioinorganic Chemistry 3:281-293 (1974) (Exhibit 18)
19. Manning, J. et al., "A Method for Gene Enrichment Based on the Avidin-Biotini Interaction. Application To Drosophila Ribosomal RNA," Biochemistry 16(7):1364-1370 (1977) (Exhibit 19); and
20. Avrameas, S., "Coupling Of Enzymes To Proteins With Glutaraldehyde. Use Of The Conjugates For the Detection Of Antigens And Antibodies," Immunochemistry, Vol. 6, pp. 43-52 (1969) (Exhibit 20).

A completed Form PTO-1449 listing the twenty (20) above-submitted documents is also attached hereto as Exhibit 21.

The first eighteen above-noted references (Exhibits 1-18) were cited by parties with an adverse interest to the present U.S. application (serial no. 08/486,0566) in a European opposition to Enzo Biochem, Inc.'s European Patent No. EP 0 286 898 B1. The opposing parties also cited three references in the aforementioned opposition which were disclosed to the Examiner on September 11, 1995, and were subsequently considered by the Examiner on April 11, 1997. These three references are: 1) Bauman, J.G.J. et al., Chromosoma (Berl) 84:1-18 (1981); 2) Ward et al.'s European Patent No. EP 0 063 879A2 (the Examiner considered this issued patent, namely, European Patent No. EP 0 063 879B1); and 3) Halloran, M.J. et al., Journal of Immunology 96:373-378 (1966).

Exhibits 19 and 20 above were disclosed in the Kourilsky et al. GB 2019408 A application, which application was cited in the September 28, 1998 Office Action issued in connection with the present patent application.

By this voluntary citation of art, Applicants and their attorney are requesting that the documents be made of record in the instant application.

The above citation of references is not a representation that these documents

Dean L. Engelhardt et al.  
Serial No. 08/486,066  
Filed: June 7, 1995  
Page 4 (Supplemental Information Disclosure Statement  
Under 38 C.F.R. §§1.56 & I.97-I.98 – March 28, 2000)

constitute a complete or exhaustive listing, nor that the above listing necessarily includes the closest or most relevant references, nor are these documents necessarily a complete listing of all references known to Applicants or their attorney. It is simply a voluntary citation of references made in good faith, which is not intended to serve in any way as a substitute for the Examiner's own search.

In view of the general and specific features described and claimed in the present application, Applicants respectfully submit that the present invention is neither suggested nor disclosed by the documents referred to above and is thus patentably distinct thereover.

Applicants do not believe, and do not submit, by the citation of these references, that these references, either by themselves or in combination with other references, render the invention *prima facie* obvious under the new duty of disclosure rules.

Applicants respectfully request that the Examiner make the above-submitted documents of record in the instant application. Applicants further request that the Examiner consider these documents as any of them may relate to the instant

The fee under 37 C.F.R. §1.17(p) for filing this Supplemental Information Disclosure Statement is \$240.00. The Patent and Trademark Office is hereby authorized to charge the amount of this fee (and any other fees in connection with this IDS) to Deposit Account Exhibit 05-1135, or to credit any overpayment thereto.

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicants

ENZO DIAGNOSTICS, INC.  
c/o Enzo Biochem, Inc.  
527 Madison Avenue, 9<sup>th</sup> Floor  
New York, New York 10022  
Tel. (212) 583-0100

Enz-5(D5)(C2)